

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Andrew T. Wilson

Serial No.: 10/684,167

Examiner: Jeffrey Donels

Filed: October 10, 2003

Group Art Unit: 2837

For: PORTABLE HAND-HELD MUSIC SYNTHESIZER AND
NETWORKING METHOD AND APPARATUS

Confirmation No.: 2311

Date: November 22, 2009

Mail Stop Appeal Briefs-Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING UNDER 37 CFR 41.52

This Request for Rehearing is responsive to the Decision on Appeal (hereinafter, the “Decision”) from the Board of Patent Appeals and Interferences (hereinafter, the “Board”) mailed September 22, 2009.

The Factual Basis Applied in Affirming the Rejection is Incorrect

Affirming the rejection of claims 11-15 and 27-30 under 35 U.S.C. § 103(a), the Board alleges that U.S. Patent App. Pub. No. 20023/0121401 to Ito (hereinafter, “Ito”) discloses wherein “*each* of musical instruments 10, 20, and 30 and mixer apparatus 40 can be implemented with apparatus like that depicted in Figure 3 (Id. at ¶ 0041), which includes, ... a mixing circuit 82....” (*emphasis in original*) See *Decision* at page 13. Thus, in order for the Board’s affirmation of the rejection of claims 11-15 and 27-30 to be correct, Ito must actually

teach wherein *each* of musical instruments 10, 20, and 30 and mixer apparatus 40 shown in FIGS. 1 and 2 of Ito include the mixing circuit 82 shown in FIG. 3 of Ito. For reasons discussed below, Ito does not, in fact, teach that which the Board alleges.

Specifically, paragraph 0041 of Ito reads:

Next, one embodiment of the electronic musical instruments used as the aforesaid music apparatus 10, 20 and a mixer apparatus of electronic musical instrument function incorporating type used as mixer apparatus 40 will be described with reference to FIG. 3.

This paragraph simply states that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40 of Ito, which are shown in FIGS. 1 and 2, will be described with respect to FIG. 3. The fact that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40 shown in FIGS. 1 and 2 can be described with respect to FIG. 3 does not mean that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40 shown in FIGS. 1 and 2 can be described with respect to FIG. 3 does not mean that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40, when taken individually, *must necessarily* include all of the components shown in FIG. 3 (including the mixing circuit 82). Indeed, upon reading paragraphs 0041-0052 of Ito, it is possible to conclude that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40, *only when taken collectively*, include all of the components shown in FIG. 3 (but when taken individually include only some of the components shown in FIG. 3).

For example, paragraph 0048 of Ito describes the relationship of musical instrument 10 shown in FIG. 2 and the apparatus shown in FIG. 3 by mapping all of the components of musical instrument 10 shown in FIG. 2 to only some of the components shown in FIG. 3. Nothing in paragraph 0048 of Ito, or in any other portion of Ito actually states that the musical instrument 10 shown in FIG. 2 includes the mixing circuit 82 shown in FIG. 3. Similarly, paragraph 0049 of Ito describes the relationship of musical instrument 20 shown in FIG. 2 and the apparatus shown in FIG. 3 by mapping all of the components of musical instrument 20 shown in FIG. 2 to only some of the components shown in FIG. 3. Nothing in paragraph 0049 of Ito, or in any other portion of Ito actually states that the musical instrument 20 shown in FIG. 2 includes the mixing circuit 82 shown in FIG. 3. Lastly, paragraph 0050 of Ito describes the relationship of mixer apparatus 40 shown in FIG. 2 and the apparatus shown in FIG. 3 by mapping all of the components of mixer apparatus 40 shown in FIG. 2 to only some of the components shown in FIG. 3, including the mixing circuit 82.

In view of the above, upon considering the teachings of Ito in their entirety, Appellant submits that only mixer apparatus 40 – *not* the electronic musical instruments 10, 20 and 30 – includes the mixing circuit 82 shown in FIG. 3. As such, Appellant submits Ito does not teach wherein *each* of musical instruments 10, 20, and 30 shown in FIGS. 1 and 2 actually includes the mixing circuit 82 shown in FIG. 3. Because Ito does not teach wherein *each* of musical instruments 10, 20, and 30 shown in FIGS. 1 and 2 actually includes the mixing circuit 82 shown in FIG. 3, the Boards affirmation of the rejection of claims 11-15 and 27-30 should be withdrawn.

***The Legal Basis Applied in Affirming the Rejection is Incorrect
Remand Requested***

As discussed above, the Board relied upon a factually incorrect interpretation of the teachings surrounding FIG. 3 of Ito to affirm the rejection of claims 11-15 and 27-30. The Board acknowledges that this interpretation is different from the interpretation presented by the examiner during prosecution. *See, e.g., Decision* at pages 11-12. The fact that the interpretation given to Ito in the Decision is different from that presented by the examiner during rejection means that the grounds for affirming the rejection of claims 11-15 and 27-30 is “new.” *See, e.g.,* MPEP 707.07(f), Form Paragraph 7.38.02, note 4, instructing the examiner to “insert the new ground(s) of rejection, e.g., *different interpretation of the previously applied reference*, newly found prior art reference(s), and provide an explanation of the rejection.” (*emphasis added*)

CONCLUSION

Appellant requests that the rejection of claims 11-15 and 27-30 be reversed.

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Respectfully submitted,

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